

ELECTION OF SPECIES

The Applicant further provisionally elects, **with traverse**, and for the purpose of searching only, species (ii), particles of a synthetic substrate at least partially coated with at least one layer of at least one metallic compound. It is believed that claims 5-11 and 15-48 are readable upon the elected species. The examiner considers claims 15-48, 50-52 and 54 to be generic¹.

The Examiner is reminded of *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) in which the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *Id.* at 331 (Emphasis in original).

In view of the above and similar case law, the Patent Office has set forth a general policy regarding restriction of Markush-type claims in M.P.E.P. § 803.02. According to the general policy as articulated in the M.P.E.P., "since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is **improper** for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Hamish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex*

¹ The Examiner states that only claims 15-48, 50-52, and 54 are generic (Page 5 of the Official Communication). However, according to the definition of a generic claim set forth in M.P.E.P. § 806.04(d), at least claims 2-4 are also generic.

parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).” (M.P.E.P. § 803.02, emphasis added).

The Examiner is also reminded that even where a provisional election of a single species is proper prior to examination on the merits, following election the Markush-type claim should be examined fully with respect to the elected species and further to the extent necessary to determine patentability. (M.P.E.P. § 803.02). The M.P.E.P. requires that should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim **will be extended** to non-elected species. (*Id.*, emphasis added).

With regard to the required species elections, Applicant once again draws the Examiner's attention to M.P.E.P. § 803, which recites: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions.” No basis as to why a search of these categories would be burdensome, let alone seriously burdensome, has been set forth in the Official Communication, as required.

In addition to showing the serious burden, the Patent Office is also under an obligation to demonstrate that the species are independent and/or distinct. M.P.E.P. § 806.04(b). No basis has been provided in the Official Communication as to why the various members of the generic classes in question are independent and/or distinct. Without meeting this obligation, the requirements have not been properly evinced. Furthermore, no evidence was provided why the instant elections are necessary in view of the claims and art.

The Applicant further submits that, under 37 C.F.R. § 1.141 and M.P.E.P. § 806.04(a), a reasonable number of species may still be claimed in one application. The Official Communication does not set forth an explanation as to why more species could not be examined together. See M.P.E.P. § 808.01(a).

As such, Applicants expressly reserve the right to traverse any subsequent divisions made by the Examiner of the present invention into "inventive groups" following the present provisional election of three species for examination.

Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

CONCLUSION

Accordingly, for at least the reasons set forth above, withdrawal of the requirement for restriction and election of species is requested and believed to be in order. Further and favorable consideration of all claims on record on the merits is respectfully requested.

In the event of any questions, regarding this Response or the application in general, it would be very much appreciated if the Examiner would telephone the undersigned attorney concerning such questions, so that the prosecution of the instant application may be expedited.

Respectfully submitted,

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